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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,089	10/29/2003	Suzanne M.K. Taussig	6032P720	6642

23504 7590 04/15/2005

WEISS & MOY PC
4204 NORTH BROWN AVENUE
SCOTTSDALE, AZ 85251

EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,089

Applicant(s)

TAUSSIG ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 7, 9-20 and 32-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

[1] Claims 7, 9-20, and 32-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable generic or linking claim. Applicant's election with traverse in the reply filed on 3/3/2005 is acknowledged. The traversal is on the ground(s) that each of the four species identified comprises at least one jewel coupled in a substantially perpendicular orientation to a display end of a post. This is not found persuasive because the structure of each identified species are different, thereby requiring an alternate search. Examiner also would like to point out that claims 1-9 are indeed not generic to each of the four species as stated by applicant, since species II selected by applicant, covering figures 3A-7B, does not have as Claim 9 states, "at least one glass pearl bead."

The requirement is still deemed proper and is therefore made FINAL.

Consequently, claims 1-6, 8, and 21-31 have been elected.

Claim Rejections - 35 USC § 102

[2] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[3] Claims 1-6, 8, 21-31 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Paye, US-1,177,893, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, Paye teaches of a mounting for a jewel comprising:

a post (P) having a bouquet insertion end (bottom of P) and a display end (top of P), said bouquet insertion end (bottom of P) dimensioned [to be inserted into a bouquet of flowers] while at the same time said display end (top of P) [being dimensioned to be] proximate said flowers; and

at least one jewel (G, S) coupled in a substantially perpendicular orientation to said display end of said post (top of P).

Examiners note: [] is an example of intended use, as it fails to further limit the structure of the claimed invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 2, wherein said post being comprised of metal (column 2, line 71, "...P designates the steel stem or pin).

Re: Claim 3, wherein said post being gold plated (It would have been an obvious matter of design choice to make the post gold plated, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Haye).

Re: Claim 4, wherein said post being silver plated (It would have been an obvious matter of design choice to make the post silver plated, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Haye).

Re: Claim 5, wherein said post having a diameter of between approximately 2-3 millimeters (P).

Re: Claim 6, wherein said post having a length of between approximately 4-6 inches (P).

Re: Claim 8, wherein said at least one jewel comprises at least one Chinese cubic zirconia stone (S in Fig. 5, as well as it would have been an obvious matter of design choice to utilize a cubic zirconia stone, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Haye. Further, applicant, on page 8, line 18 states, "...be clearly understood that substantial benefit may be derived from the use of other gems and stones").

As for Claim 21, Paye teaches of a mounting for a jewel comprising:

a post (P) having a bouquet insertion end (bottom of P) and a display end (top of P), said bouquet insertion end (bottom of P) dimensioned [to be inserted into a bouquet of flowers] while at the same time said display end (top of P) [being dimensioned to be] proximate said flowers; and

at least one setting (B,C) coupled in a substantially perpendicular orientation to said post (P) proximate said display end (above P); and

at least one jewel (S) dimensioned to be secured into said at least one setting (B,C) and dimensioned to be coupled in a substantially perpendicular orientation to said display end of said post.

Examiners note: [] is an example of intended use, as it fails to further limit the structure of the claimed invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 22, wherein said at least one jewel comprises at least one Chinese cubic zirconia stone (S in Fig. 5, as well as it would have been an obvious matter of design choice to utilize a cubic zirconia stone, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Hays. Further, applicant, on page 8, line 18 states, "...be clearly understood that substantial benefit may be derived from the use of other gems and stones").

Re: Claim 23, wherein said at least one Chinese cubic zirconia stone being heart cut and having a diameter of approximately 14 millimeters (S in Fig. 5, as well as it would have been an obvious matter of design choice to utilize a cubic zirconia stone heart cut and listed dimensions, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention

disclosed by Haye. Further, applicant, on page 8, line 18 states, "...be clearly understood that substantial benefit may be derived from the use of other gems and stones").

Re: Claim 24, wherein said at least one Chinese cubic zirconia stone being round cut and having a diameter of approximately 14 millimeters (S in Fig. 5, as well as it would have been an obvious matter of design choice to utilize a cubic zirconia stone round cut with the listed dimensions, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Haye. Further, applicant, on page 8, line 18 states, "...be clearly understood that substantial benefit may be derived from the use of other gems and stones").

Re: Claim 25, wherein said at least one Chinese cubic zirconia stone being emerald cut and having a diameter of approximately 16 millimeters and having a depth of approximately 12 millimeters (S in Fig. 5, as well as it would have been an obvious matter of design choice to utilize a cubic zirconia stone emerald cut with the listed dimensions, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Haye. Further, applicant, on page 8, line 18 states, "...be clearly understood that substantial benefit may be derived from the use of other gems and stones").

Re: Claim 26, wherein said post being comprised of metal (column 2, line 71, "...P designates the steel stem or pin).

Re: Claim 27, wherein said post being gold plated (It would have been an obvious matter of design choice to make the post gold plated, as Applicant has not disclosed that it solves any

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stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Haye).

Re: Claim 28, wherein said post being silver plated (It would have been an obvious matter of design choice to make the post silver plated, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Haye).

Re: Claim 29, wherein said post having a diameter of between approximately 2-3 millimeters (P) and said post having a length of between approximately 4-6 inches (P).

Re: Claim 30, wherein a bottom portion (D) of said at least one setting being soldered to said post proximate said display end (column 2, line 83, stating, "The seat-member D is preferably soldered to the end of the stem P).

Re: Claim 31, further comprising at least one earring back (C), said earring back defining a bore therethrough (Fig. 2) and dimensioned to be slidably coupled around said post proximate said display end (Fig. 2), said earring back having a top portion being coupled to a bottom portion (D) of said at least one setting.

Conclusion

[4] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of jewel; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

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[5] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is ~~██████████~~ ^{See below dr} Due to a future move, however, this number will change after the 31st of March. After this date, the examiner can be reached at (571) 272- 7082. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Examiner
Art Unit 3677


ROBERT J. SANDY
PRIMARY EXAMINER